



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,401	03/27/2001	Laurent Humeau	397272000700	3802
25225	7590	08/10/2004	EXAMINER	
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332			LI, BAO Q	
		ART UNIT	PAPER NUMBER	
			1648	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/819,401	HUMEAU ET AL.	
	Examiner	Art Unit	
	Bao Qun Li	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 April 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 3-6, 8-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claims 1, 3-6 and 8-21 are pending.

Response to Amendment

The response to the Office Action, paper No. 19, filed 03/25/03 has been acknowledged.

Applicants wish Office to clarify following two specific issues for the prosecution on the record. In order to address Applicant's concern, the finality of the previous Action has been vacated to incorporate the inherency reasoning into this rejection.

Applicants are reminded that other issues made by previous Office Final Rejection mailed on October 10, 2002 are still outstanding and will not be repeatedly stated in the following action.

1. New Matter Objection and Rejection

Applicants asserted that either Advisory Action or the Interview Summary on November 25, 2002 does not reflect the withdrawn of the new matter issue because during the interview on November 25, 2002, SPE Housel indicated that the objection under 35 USC 132 and rejection under 35 USC 112, first paragraph alleging the introduction of new matter will be withdrawn.

On the record, during the Interview on Nov. 25, 2002, SPE Housel commented that the objection under 35 USC 132 and rejection under 35 USC 112, first paragraph alleging the introduction of new matter will be revisited according to whether the amendment can be found in the disclosure of specification as it was originally filed. Since Office has not found the support of the amendment according to the disclosure as it was originally filed, the objection and rejection on the new matter issue are maintained in the advisory Action. SPE Housel has acknowledged the fact and signed the Advisory Action mailed on January 15, 2003. The rejection would be withdrawn if Applicants point out the support for the amendment. Otherwise, the rejection on this issue is still maintained and made Final.

2. The prior art rejection of Dropulic (USP 6,232,120)

Claims 1, 3-6, 8, 9, 14-21 are still rejected under 35 U.S.C. 102(e) as being anticipated by Dropulic et al. (US Patent. No. 6,232,120B1) on the same ground as stated in the previous office action.

Applicant asserts that the inherency basis of this anticipatory rejection was not clearly established in the previous Office Action of October 10, 2002, but instead was raised for the first time during the interview on November 25, 2002. In order to address Applicant's concern, the finality of the previous Action has been vacated to incorporate the inherency reasoning into this rejection.

The Office position holds that Dropulic teaches a conditionally replicating HIV vector having all the structural limitations set forth in the claims. In other words, Dropulic teaches the same HIV vector as claimed. However, Dropulic fails to specifically recite that this vector is capable of inhibiting integration of the wild-type virus into the host cell genome. Nonetheless, Dropulic is inherently capable of such inhibition as the vector taught is structurally identical to the claimed vector. Where a prior art structure is identical to a claimed structure, that prior art structure must inherently be capable of performing any function recited for the claimed structure. If it were not capable, then the claimed structure is incomplete in failing to recite structure, which is not present in the prior art but renders claimed structure capable of performing the claimed function. In other words, the function is directed to intended use which fails to define over prior art that is structurally identical to that claimed.

Because Office cannot find the claimed method is disclosed by using a structural different vector as taught by the prior art USP "120", the rejection made by previous Office is still maintained and made Final.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1648

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Qun Li whose telephone number is 703-305-1695. The examiner can normally be reached on 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Bao Qun Li

July 26, 2004


JAMES HOUSEL 8/9/04
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600